



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,825	05/10/2001	Todd A. Schelling	10559-416001/P10374	6463

7590

08/05/2005

Joni D. Stutman-Horn
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025

EXAMINER

SCHUBERT, KEVIN R

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,825

Applicant(s)

SCHELLING ET AL.

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2137

DETAILED ACTION

Claims 1-23 have been considered.

Continued Examination Under 37 CFR 1.114

5 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/20/05 has been entered.

10

Claim Objections

Claim 19 is objected to because of the following informalities: there is no space between "17" and "further". Appropriate correction is required.

15

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20

Claim 17 recites the limitation "the optional feature" in part c. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

25

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

30

Art Unit: 2137

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5 Claims 1-4, 8-14, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tello, U.S. Patent No. 6,463,537.

As per claims 1, 8, and 17, the applicant describes a method comprising the following limitations which are met by Tello:

- 10 a) receiving, at a BIOS, a message from an authorized party (Col 31, lines 29-60);
- b) authenticating the message (Col 31, lines 29-60);
- c) controlling a state of an optional feature of a system resource, using the BIOS, according to the message, wherein the message comprises information to determine the optional feature, and wherein the message further comprises a digital signature (Col 31, lines 29-60; Col 5, lines 15-48).

15 As per claims 2, 11-12 and 18, the applicant describes the method of claims 1, 8, and 17, which are met by Tello, with the following limitation which is also met by Tello:

 Further comprising verifying an identifier in the message against a unique system identifier (Col 5, lines 15-48; Col 9, lines 26-30).

20 As per claims 9 and 10, the applicant describes the system of claim 8, which is met by Tello, with the following limitation which is also met by Tello:

 Further comprising a write-once non-volatile unit for storing a public key accessible by the BIOS (Col 15, lines 6-13).

25 As per claims 13 and 14, the applicant describes the system of claim 8, which is met by Tello, with the following limitation which is also met by Tello:

Art Unit: 2137

Further comprising a secure non-volatile location for storing at least one of the optional features to be enabled, the location being readable and writable by the BIOS (Col 26, lines 18-43).

As per claims 3-4 and 19-20, the applicant describes the system of claims 1 and 17, which are met by Tello, with the following limitation which is also met by Tello:

Further comprising writing the message into a secure non-volatile location (Col 26, line 63 to Col 27, line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of Nevis, U.S. Patent No. 6,581,159.

As per claims 5 and 21, the applicant describes the method of claims 1 and 17, which are met by Tello, with the following limitation which is met by Nevis:

Further comprising splicing the content of the message into an execution path of the BIOS, wherein the splicing comprises at least one of modifying the BIOS or erasing a portion of the BIOS, in response to the message (Nevis: Col 4, lines 57-67; Col 6, lines 28-35);

Tello teaches all the limitations of claims 1 and 17. However, Tello does not teach the limitations of the above claim. Nevis discloses a system in which a BIOS update message is sent to the BIOS and the BIOS is altered at execution time. Nevis satisfies the limitations of the above claim as Nevis teaches splicing a message (Col 6, lines 28-35) into an execution path of the BIOS at run-time. It would have

Art Unit: 2137

been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Nevis with those of Tello because doing so allows the message sent to be executable at run-time by modifying the run-time status of the BIOS. The combination would be advantageous as the primary reference teaches communicating with the system during boot-up time.

5

Claims 6, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of Ala-Laurila, U.S. Patent No. 6,704,789.

As per claims 6, 16, and 22, the applicant describes the method of claims 1, 8, and 17, which are met by Tello, with the following limitation which is met by Tello and Ala-Laurila:

Further comprising loading and executing content of the message using the BIOS at run-time, wherein the message is received via a network transmission (Tello: Col 31, lines 29-60; Ala-Laurila: Fig 3A);

Tello discloses all the limitations of claims 1, 8, and 17. Tello also discloses loading and executing content of the message using the BIOS at run-time. Tello does not disclose that the message is sent through a network transmission. Tello is silent as to how the communication between the smartcard and the system takes place. Ala-Laurila discloses the well-known idea that communication between two entities can take place through a network environment. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Ala-Laurila with those of Tello because sending information through a network transmission is well-known as an effective method of transmitting data.

25

Claims 7, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of Obata, U.S. 2001/0025312.

As per claims 7, 15, and 23, the applicant describes the method of claims 1, 8, and 17, which are met by Tello, with the following limitation which is met by Obata:

Art Unit: 2137

Further comprising updating a feature set of the system BIOS according to the message (Obata: Fig 2);

The applicant has defined "updating a feature set" to signify updating the status of system features (Specification: page 5, line 22). The applicant has further signified that updating the status of system features is preferably implemented in a table-like fashion to keep track of the status of system resources (24 of Fig 1). Obata discloses the idea of updating the status of system features in a table-like fashion. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Obata with those of Tello because updating a feature set provides a convenient way to check the status of resources within a system.

Response to Arguments

Applicant's arguments, see Remarks, filed 6/20/05, with respect to the 112 rejection of claim 5 have been fully considered and are persuasive. The 112 rejection of claim 5 has been withdrawn. The examiner notes that he appreciates the applicant's efforts in the Remarks to better clarify the limitation of the claim.

Applicant's arguments with respect to claims 1,8, and 17 have been fully considered but they are not persuasive. The applicant argues that Tello does not teach a message comprising information to determine the optional features. The examiner disagrees. The applicant's new limitations still do not define over the primary reference. Tello discloses a system in which a user is allowed to configure features of system resources, such as which resources are to be enabled or disabled by the BIOS for the user (Col 26, lines 18-33). The system then establishes specific hash numbers for the user which are based on information provided by the user. Tello defines a hash number to be a digital signature (Col 5, lines 21-22). The system stores the hash numbers internally in the security engine memory and externally in the user's smart card. At boot-up time, an authorized user presents his smart card to the system and communication between the smart card and system is synchronized. The BIOS receives a hash number (digital signature) from the user (part a). The BIOS then authenticates the message by

Art Unit: 2137

comparing the hash number to a hash number stored internally (part b). If the hash numbers match, the BIOS then looks in the security configuration table to determine which system resources are allowed to be loaded by the particular user (Col 31, lines 55-58). Thus, the message comprises information to determine the optional features as claimed (part c).

5

Applicant's arguments with respect to claims 2,11-12, and 18 have been fully considered but they are not persuasive. The applicant argues that Tello does not teach a unique system identifier. The applicant argues that the secret identifier of the motherboard is the same for all motherboards (Col 9, lines 20-25). The examiner agrees with the applicant's statement but notes that the rejection was not based on this argument. The message comprises a hash number identifier uniquely based on personal information input by the user (Col 5, lines 15-24). The security engine has a complementary unique identifier stored in memory. The identifier in the message (hash number) is verified against a unique system identifier of the system (stored hash number).

10

15

Applicant's arguments with respect to claims 3-4,13-14, and 19-20 have been fully considered but they are not persuasive. The applicant argues that the system does not receive a message. This argument has already been addressed and is inconsistent with the primary reference.

20

Applicant's arguments with respect to the rejection(s)of claim(s) 6,16, and 22 have been fully considered and are persuasive. Tello discloses communication between the smart card and the system but does not mention that this communication takes place in a networking environment. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

25

Applicant's arguments with respect to the rejection(s)of claim(s) 7,15, and 23 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Art Unit: 2137

Applicant's arguments with respect to the rejection(s) of claim(s) 21 have been fully considered and are persuasive. Neither Tello nor Merkin disclose the limitations of claim 21 as correctly noted by the applicant. Therefore, the rejection has been withdrawn. However, upon further consideration, a new
5 ground(s) of rejection is made.

Conclusion

This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should
10 be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)
20 at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER